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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,075	09/06/2006	Marco Mario Tivelli	2585-0129PUS1	2845

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EXAMINER

SHEVIN, MARK L

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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09/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

DETAILED ACTION

Status:

1. Claims 1-20, filed as a preliminary amendment on October 24th, 2005, are pending.

Telephonic Election

2. No telephone call was made in this case given the 371 status of the case with foreign Applicants.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-8 and 11-20, drawn to a seamless steel tube.

Group II, claims 9-10, drawn to a process of making a seamless steel tube.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

4. Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions,

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considered as a whole, makes over the prior art.” (Rule 13.2). The question of unity of invention has been reconsidered retroactively by the examiner in view of the search performed; a review of **Kondo** (JP 09-235617) makes clear that the claimed special technical feature (the product of claim 1) is obvious in view of the prior art.

Kondo teaches a seamless steel tube with a composition that overlaps each and every alloying component of claim 1 and thus establishes a prima facie case of obviousness as MPEP 2144.05, para I states: “In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists.”

Element	Instant Claim 1	Kondo
C	0.06 - 0.13	0.02 – 0.15
Mn	1.00 – 1.30	0.5 – 2
Si	0 – 0.35	0.1 – 1.5
P	0 – 0.015	0 – 0.05
S	0 – 0.003	0 – 0.01
Mo	0.1 – 0.2	0 – 1.5
Cr	0.10 – 0.30	0 – 1.5
V	0.050 – 0.10	0 – 0.3
Nb	0.020 – 0.035	0 – 0.08
Ni	0.30 – 0.45	0 – 2.5
Al	0.015 – 0.040	0.001 – 0.5

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Ti	0 – 0.020	0 – 0.08
N	0 – 0.010	0 – 0.01
Cu	0 – 0.2	0 – 0.8
Fe	Balance	Balance

Thus, the Kondo appears to demonstrate that the technical feature does not define a contribution which each of the inventions, considered as a whole, makes over the prior art. Thus, lack of unity becomes apparent “a posteriori” after taking the prior art into consideration. Accordingly, the prior art of the record supports restriction of the claimed subject matter in to the groups as mentioned immediately above.

Joint Inventors

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Rejoining practice

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Conclusion

-- Claims 1-20 (All pending) are restricted

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shevin whose telephone number is (571) 270-3588 and fax number is (571) 270-4588. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Shevin/

/Roy King/

Supervisory Patent Examiner, Art Unit 1793

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September 2nd, 2008